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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,754	09/28/2001	Yoshihiro Itoh	05905.0153	3110

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EXAMINER

LABAZE, EDWYN

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/964,754	Applicant(s) ITO ET AL.	
	Examiner EDWYN LABAZE	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-43 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 26-43 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 1/21/2005.
2. Claims 26-43 are presented for examination.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 26-39, 41, and 43 are rejected under 35 U.S.C. 102(a) as being anticipated by Hymel et al. (WO 00/03328).

Re claims 26, 32, 37, 39, and 41: Hymel et al. discloses method and apparatus in a wireless communication system for using selective call receiver to provide demographic information, which includes a personal database for registering the user's personal information sent from the portable terminal [herein a Selective Call Receiver/SCR 10; in the form of a pager] (page 10, lines 4-7); means for creating an electronic coupon bar code [which is performed by the computer 138] by presuming the user's tastes [interpreted as the user's purchasing history/habits] according to the user's personal information registered in the personal database, by preparing the electronic coupon content that suits the user's tastes and by encoding the prepared electronic coupon content (page 9, lines 14+; page 10, lines 4+), and means for delivering image data [through the link 146, messaging system 148; as shown in fig. # 7],

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including the electronic coupon bar code, to the user's portable terminal, wherein the portable terminal comprises a storage means [herein described as coupon memory 51; page 5, lines 26] for storing the delivered image data and a displaying means [display 28; page 5, line 14] for displaying the image data, and wherein an information processing terminal [herein POS 154; page 10, line 14] having a bar code reader [herein scanner 157; page 10, line 16] reads, using the bar code reader, the electronic coupon bar code contained in the image, data displayed on the display means of the portable terminal, recognizes the electronic coupon content according to the electronic coupon bar code that has been read, performs the necessary processing to provide a service according to the recognized electronic coupon content, and sends new personal information generated by the service to the server so that the new personal information is reflected in the electronic coupon content for the next delivery (page 10, lines 4-25). Hymel et al. further teaches a system and method that recognizes the specified user and electronic coupon content according to the bar code, and performs the necessary processing to provide a service according to the electronic coupon content (page 11, lines 32+). Hymel et al. discloses a personal database for registering the user's personal information [herein described as the demographic information, i.e. user's age, sex, location, interests and the like stored in the demographic database 48] sent from the portable terminal (page 6, lines 23-37), and a second personal database for registering the user's purchase history information sent from the information processing terminal (page 9, lines 14+).

Re claims 27, 33, 38: Hymel et al. teaches a system and method, wherein the server 138 has a product information database for registering specified information according to a plurality of products (page 12, lines 1+), wherein the means for creating the electronic coupon bar code 52

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creates an electronic coupon bar code including a user ID code [herein a unique identifier] for the user (page 6, lines 1-10), wherein the information processing terminal specifies the user by reading, using the bar code reader, the electronic coupon bar code displayed on the display means of the portable terminal, and specifies a product selected by the user by using the bar code reader, and sends information about the user's selected product according to the specified user and product (page), and wherein the server 138 registers the received information about the user's selected product, and presumes the user's tastes according to a purchase history of the user so that said presumption of the user's tastes is reflected in the electronic coupon content for the next delivery (page 9, lines 1+).

Re claim 28: Hymel et al. discloses a system and method, having a program [such as the over-the-air programming techniques] stored therein for causing a computer to download data in the service providing system (page 13, lines 35+).

Re claims 29, 34: Hymel et al. teaches a system and method, wherein the server specifies the electronic coupon content for the next delivery on the basis of the user's purchase history in the personal database, so that a better service rate [herein described as applicable discount] will be provided with regard to products having a high purchase frequency (page 10, lines 15-19; page 14, lines 35+).

Re claims 30, 35: Hymel et al. discloses a system and method, wherein the server specifies the electronic coupon content for next delivery on the basis of the information, which is registered in the product information database, regarding products [through the maildrop messages, which describe advertisements, new items, and the like] for which a seller [herein

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broadly interpreted as the affinity group] wants to increase sales, and on the basis of the user's purchase history in the personal database (page 7, lines 22+; page 8, lines 5+).

Re claims 31, 36 and 43: Hymel et al. teaches a system and method, wherein when the received bar code of the product purchased by the user corresponds to an identification of a previously determined discount product, the server notifies the information processing terminal of an electronic coupon bar code to allow application of the discount to the price of the product purchased by the user (page 14, lines 23-37).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 40 and 42 are- rejected under 35 U.S.C. 103(a) as being unpatentable over Hymel et al. (WO 00/3328 A1) in view of Layton et al. (U.S. 6,829,478).

The teachings of Hymel et al. have been discussed above. Hymel et al. further discloses using a MC68HC05 by Motorola, Inc.

Hymel fails to specifically suggest means of delivering the information about the specific product via e-mail to the user's portable terminal or the user's accessed Internet web pages.

Layton et al. teaches a portable terminal comprising of a MC68HC05 processor by Motorola, Inc with means of receiving information/data via e-mail and Internet technologies (col.11, lines 4+; col.12, lines 32-62).

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In view of Layton et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Hymel et al. means of delivering the information about the specific product via e-mail to the user's portable terminal or the user's accessed Internet web pages. Furthermore, such modification would provide a secure interactive and remotely accessible information management network capable of sending voice and text notifications. Moreover, such modification would have been an obvious extension as taught by Hymel et al., therefore an obvious expedient.

Response to Arguments

7. Applicant's arguments with respect to claims 26-43 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ferber et al. (US 2002/0004746) discloses E-coupon channel and method for delivery of e-coupons to wireless devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
April 29, 2005



THIEN M. LE
PRIMARY EXAMINER